REMARKS/ARGUMENTS

I. ***Rejection of Claim 6 under 35 U.S.C. § 102(b)***

The rejection of Claim 6 under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,735,544 (the "*Buckner* reference") is respectfully traversed. The M.P.E.P. provides at §2131:

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in ... claim." *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Rejection under §102 with *Buckner* is not understood and the claims, even previous to amendment, are not shown or even vaguely intimated by *Buckner*. *Buckner* is a page turning device being mounted on the end of a cylindrical writing instrument such as a pencil. The Examiner contends that body 12 of the *Buckner* reference is a weight as taught by the present application. Body 12 is a sphere having deformable protuberances which extend outward providing a non-uniform surface for the body 12. (*See*: Col. 2, lines 65-Col. 3, lines 1-2, Figs. 1-3). The body 12 and protuberances 16 comprises a deformable and elastic material. (See: Col. 3, lines 47-50). In contrast, the present application teaches an undeformable weight, i.e. a dense weight, as recited

in amended Claim 6 (*See Specification*: page 4, lines 1-32; page 6, lines 1-2; page 7, line 25 and page 9, lines 13-14). The *Buckner* reference does not teach this element as set forth in the claim. As such, anticipation will not be found when the prior art is lacking or missing a specific feature or structure of the claimed invention.

Notwithstanding that the *Buckner* reference does not anticipate amended Claim 6, Applicant further submits the following argument relating to the Examiner's remark. The Examiner contends that Claim 6 "is nothing more than a claim of intended use." A holding of no anticipation may be found in instances where the general subject matter is the same, but the specific application or use is different. *Union Oil Co. of Cal. V. Atlantic Richfiled Co.*, 208 F.3e 989, 54 USPQ2d 1227 (Fed. Cir. 2000), *cert. denied*, 531 U.S 1183 (2001). Since the Examiner contends that the *Buckner* reference and the present application are "physical activities engaged for pleasure" (i.e., general subject matter), anticipation cannot be found because the specific applications of the *Buckner* reference and the present application are different. [1] Because the Examiner is relying on a prior art process to reject a claimed device, the prior art process would have to

[1] The Applicant is not arguing that the *Buckner* reference is nonanalogous to the field of the present application under the anticipation standard.

show the functions as well as the structures to anticipate the claimed invention. The *Buckner* reference lacks both the function and structure of the present application.

Furthermore, the Applicant submits that the prior art reference must enable the claimed subject matter to support a rejection based on anticipation. *Elan Pharms. Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 68 USPQ2d 1373 (Fed. Cir. 2003). The present application uses an undeformable weight having a uniform surface such that the positioning of the undeformable weight and the center of mass is configured to direct the effect of the undeformable weight in a concentrated manner to the forearms of the user when used in the manner of the sport. In contrast, the *Buckner* reference uses an elastic body member having a non-uniform surface to turn paper sheets. As such, this reference does not enable that which it is asserted to anticipate.

II. *Rejection of Claim 6 under 35 U.S.C. § 103(a)*

The rejection of Claim 6 under 35 U.S.C. § 103(a) as being allegedly unpatentable by U.S. Patent No. 5,215,307 (the "Huffman reference") is respectfully traversed.

A prima facie case of obviousness is established when one or more references that were available to the inventor and teach that a suggestion to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

Under M.P.E.P. § 706.02(j), three basic criteria must be met for the *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, prior art may be considered not to teach an invention and thereby may fail to support an obviousness rejection, particularly when the stated objectives of the prior art reinforce such an interpretation. *WMS Gaming Inc., v. International Game Tech.*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999).

The *Huffman* reference teaches a training exercise method. The method provides a normal balance to the user while the user swings a counter weighted device. (*See*: Abstract)(Emphasis added). The device includes a shaft with weights at opposing ends that counter balance each other. In the background section, the *Huffman* reference discloses that a training device having a weight at only one end of a training device results in the disadvantage of pulling the user toward the weight. (*See*: Col. 1,

lines 10-11). Furthermore, the *Huffman* reference discloses that a need exists for an exercise method that does not affect the balance of the user while performing the exercise. (*See*: Col., lines 20-21). In fact, the *Huffman* reference states that the "key is the counter balanced weights at opposite ends of the shaft with one of the weights being between the hands on the grip and the user's body." (*See*: Col. 2, lines 54-57)(Emphasis added).

In contrast, the present application teaches that the positioning of the weight, the positioning of its center of mass and the sizing of the handle circumference are configured to direct the effect of the weight in a concentrated manner to the forearms of the user, as recited in amended Claims 1, 15 and 17. (*See Specification*: page 1, line 22, page 2, lines 8-9 and page 10, lines 22-26). In other words, the single weight of the present application results in an unbalanced force in order to direct the concentration of the effect of the weight to the user's forearm.[2] Furthermore, in order to concentrate the effect of the weight to the user's forearm, the weight must be at the end of the shaft. As

[2] Applicant respectfully notes that the *Huffman* reference requires opposing and counter balancing weight. Amended Claims 1, 15 and 17 recite the device consists essentially of a weight. A claim that depends from a claim that "consists of" the recited elements or steps cannot add an element or step. When the phrase "consists of" appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause; other elements are not excluded from the claim as a whole. M.P.E.P. § 2111.03 Transitional Phrases, (*citing*: *Mannesmann Demag Corp. v. Engineered Metal Products Co.*, 793 F.2d 1279, 230 USPQ 45 (Fed. Cir. 1986). >See also *In re Crish*, 393 F.3d 1253, 73 USPQ2d 1364 (Fed. Cir. 2004)).

such, the weight is not positioned between the user's hand and the user's body as taught and emphasized by the *Huffman* reference.

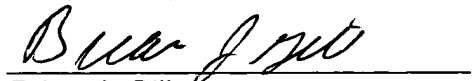
Since the present application uses a single weight at the end of the shaft to provide an unbalanced weight, one skilled in the art would not be motivated to seek out the *Huffman* reference due to the required balanced weights and the stated objectives of the *Huffman* reference. Accordingly, the *Huffman* reference does not teach a suggestion or motivation to modify in order to achieve the present application. Additionally, the *Huffman* reference does not teach or suggest all of the present claim limitations such as the positioning of the center of mass and the sizing of the handle circumference. These limitations direct the effect of the weight in a concentrated manner to the forearms of the user. As noted in the enclosed DVD illustrating a prototype video relating to the application, the experts repeatedly assert that speed and power come from the forearms (*See also*: video presentation which highlights forearm strength exercises). Furthermore, as shown in the video presentation, the single weight positioned at the end of the end the second end allows the user to swing the device near the body of the user.

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner withdraw all presently outstanding rejections. It is believed that a full

and complete response has been made to the outstanding Office Action, and as such, the present applicant is in condition for allowance.

Entrance of the amendment and passage of the case to issue are therefore respectfully requested. If the Examiner believes that personal communication will expedite prosecution of the application, the Examiner is invited to telephone the undersigned at (314) 238-2400.

Respectfully submitted,



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